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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,621	07/13/2001	Yukio Maruyama	089367-0114	2132

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,621	MARUYAMA, YUKIO	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 19-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/13/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 9/01/2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-4, 6, 9-11, 13-15, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Heckel (U.S. Patent No. 6,036,601).** Heckel teaches a system and method of inserting advertisements into a virtual world that includes all of the limitations recited in the above claims.

Regarding claims 1-4, 9-11, 13-15, 19, and 20, Heckel teaches a server that sends an instruction to a client to show an advertisement (Column 3, Lines 37-43), and a client that displays a 3-diminsional virtual space and shows 3-dimensional advertisements (Column 4, Lines 59-67 and Column 5, Lines 1-5). Heckel also teaches a client as displaying an avatar controlled by the user (Column 2, Lines 46-53), and a predetermined position (plug-in) where the advertisement is to be shown (Column 3, Lines 52-57). Heckel teaches a memory storing an advertisement (inherently containing information on the item to be advertised) and movement of the advertisement (video clip advertisements have movement embedded in them which reads on changing a position)

(Column 5, Lines 3-5). Examiner asserts that since applicant's 3-dimensional advertisement (and world) is displayed on a 2-dimensional display device, applicant's advertisement (and virtual world) is actually only 2-dimensional. A video clip has the same number of dimensions as applicant's advertisement (and virtual world), and in the same way as applicant's invention, gives the perception of 3 dimensions. Thus, the advertisement video clips of Heckel (which inherently include modeling data that shows the clips to be animating) read on the 3-dimensional advertisement image in applicant's claims.

Regarding claim 6, Heckel teaches a memory storing outline IDs (plug-ins) (inherently sent to the client when the client plays the game), and displaying an advertisement in accordance with the outline data (Column 5, Lines 65-67 and Column 6, Lines 1-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 5, 12, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Kusumoto (U.S. Patent No. 6,954,728).**

Regarding claims 5, 12, 21, and 22, Heckel doesn't specify audio in the game advertisements. Kusumoto teaches advertisements in a virtual world game that contain audio elements (Column 6, Lines 50-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include audio in the advertisements of Heckel. This would draw more of the user's attention towards to advertisement.

3. **Claims 7, 8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Hunter (U.S. Pub No. 2002/0156858).**

Regarding claims 7, 8, and 16, Heckel teaches a game that implements a virtual world (a fake representation of real surroundings). Heckel doesn't specify the timing of advertisements. Hunter teaches a real world advertisement display that sells time slots to advertisers (inherently measuring an amount of time between advertisements and displaying appropriate ads at the necessary times) (Paragraph 0029). It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the real world advertisement display timing mechanism of Hunter in the virtual world advertisement display of Heckel. This would allow more advertising revenue to be gathered by the game server.

ALTERNATIVE Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **ALTERNATIVELY, Claims 1-4, 9-11, 13-15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Burke (U.S. Patent No. 5,848,399).**

Regarding claims 1-4, 9-11, 13-15, 19, and 20, Heckel teaches a server that sends an instruction to a client to show an advertisement (Column 3, Lines 37-43), and a client that displays a 3-diminsional virtual space and shows 3-dimensional advertisements (Column 4, Lines 59-67 and Column 5, Lines 1-5). Heckel also teaches a client as displaying an avatar controlled by the user (Column 2, Lines 46-53), and a predetermined position (plug-in) where the advertisement is to be shown (Column 3, Lines 52-57). Burke teaches a 3-dimensional virtual world in which a 3-dimensional advertisement for a real item (a model with outline data) is moved to a predetermined position within the virtual world at the request of a user (Figures 9-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to move the advertisement within the virtual world to allow the user to get a better view of the item or to show different facts about the item such as nutritional information as taught by Burke (Figure 11).

Response to Arguments

5. The references on the IDS filed July 13, 2001 have now been considered.

In response to the 102 rejections, Applicant argues "video clips are not three-dimensional advertisement images, but rather two-dimensional videos. Also, video clips are not a three-dimensional virtual model of a real item to be advertised". Based on this statement, Examiner asserts that Applicant's invention is not a 3-dimensional virtual world, but a 3-dimensional representation displayed on a 2-dimensional surface. This is also an adequate description of a video, as shown in this example: If a user were to create a 3-dimensional representation depicting the interior of the White House, this would be no different in dimension than a video that is taken of the interior of the White House, except that the video would be more detailed and accurate. If applicant were to claim that the video taken of the White House has only 2 dimensions, no less can be said of Applicant's virtual world or advertisement. Since the video clips of Heckel are mapped onto the virtual world of Heckel, the movement and changing of positions of the video occur within the virtual world, and Heckel is still a 102 reference over the above claims.

However, Examiner has found new art that appears to be relevant to the invention as claimed and has applied this art in an alternative 103 rejection above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB

JEFFREY D. CARLSON
PRIMARY EXAMINER